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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
08/799,913	02/13/97	KARIN	[illegible]17004

18M2/0922

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EXAMINER	
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ART UNIT	**PAPER NUMBER**
1814	6

DATE MAILED: 09/22/97

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on 2/13/97

☐ This action is **FINAL**.

☒ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 12, 14, 15 & 17 is/are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.
☐ Claim(s) _____ is/are allowed.
☒ Claim(s) 12, 14, 15 & 17 is/are rejected.
☐ Claim(s) _____ is/are objected to.
☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
☐ The specification is objected to by the Examiner.
☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.
☐ received in Application No. (Series Code/Serial Number) _____.
☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of Reference Cited, PTO-892
☒ Information Disclosure Statement(s), PTO-1449, Paper No(s): _____
☐ Interview Summary, PTO-413
☒ Notice of Draftperson's Patent Drawing Review, PTO-948
☐ Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

PTO-

The first paragraph of the specification now reads "This is a continuation of copending application Serial No. 08/444,393, filed May 19, 1995, now U.S. Patent 5,605,808, which is a continuation-in-part application of U.S. Serial No. 08/220,602, filed March 25, 1994, which is a continuation-in-part application of U.S. Serial No. 08/094,533 filed July 19, 1993". Apparently it should read "This is a continuation of copending application Serial No. 08/444,393, filed May 19, 1995, now U.S. Patent 5,605,808, which is a divisional of 08/276,860, filed July 18, 1994, now U.S. Patent 5,593,884, which is a continuation-in-part application of U.S. Serial No. 08/220,602, filed March 25, 1994, which is a continuation-in-part application of U.S. Serial No. 08/094,533 filed July 19, 1993". Appropriate correction is required.

Claim 12 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 12 is confusing and indefinite in the recitation of "is carried out under conditions b) measuring..." Parts of the claim have apparently been left out. Apparently "sufficient to allow the components to interact; and" was intended to be between "conditions" and "b) measuring" in the recitation *supra*, as in U.S. Patent 5,605,808. The assumption is made that this was intended in the following action.

Claims 12, 14, 15 and 17 are directed to the same invention as that of claims 24-31 of commonly assigned application 08/604,334. The

issue of priority under 35 U.S.C. 102(g) and possibly 35 U.S.C. 102(f) of this single invention must be resolved.

Since the Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302), the assignee is required to state which entity is the prior inventor of the conflicting subject matter. A terminal disclaimer has no effect in this situation since the basis for refusing more than one patent is priority of invention under 35 U.S.C. 102(f) or (g) and not an extension of monopoly.

Failure to comply with this requirement will result in a holding of abandonment of the application.

Claims 12, 14, 15 and 17 are directed to an invention not patentably distinct from claims 24-31 of commonly assigned application 08/604,334.

Commonly assigned application 08/604,334 would form the basis for a rejection of the noted claims under 35 U.S.C. § 103 if the commonly assigned case qualifies as prior art under 35 U.S.C. § 102(f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee is required under 37 C.F.R. § 1.78(c) to either show that the conflicting inventions were commonly owned at the time the invention in this application was made or to name the prior inventor of the conflicting subject matter. Failure to comply with this requirement will result in a holding of abandonment of the application. A showing that the inventions were commonly owned at the

time the invention in this application was made will preclude a rejection under 35 U.S.C. § 103 based upon the commonly assigned case as a reference under 35 U.S.C. § 102(f) or (g).

The non-statutory double patenting rejection, whether of the obvious-type or non-obvious-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornam*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321 (b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78 (d).

Effective January 1, 1994, a registered attorney or agent of record may sign a Terminal Disclaimer. A Terminal Disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 12, 14, 15 and 17 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 24-31 of copending application Serial No. 08/604,334. Although the conflicting claims are not identical, they are not patentably distinct from each other because essentially the only difference between these claims and the claims of 08/604,334 are that the claims in that case are drawn to identifying a composition affecting a C-jun kinase while the claims in this application are drawn to one of the specific kinases in the specification. An art rejection was made in the parent application that resulted in this limitation being added. This art rejection also has been made in 08/604,334.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(f) he did not himself invent the subject matter sought to be patented.

Claims 12, 14, 15 and 17 are rejected under 35 U.S.C. § 102(f) because the applicant did not invent the claimed subject matter. Claims 24-31 of 08/604,334 are directed to the same thing as the instant claims. Neither the inventive entity or assignee are the same as the instant application.

No art rejection is being made because the kinase of the instant claims has been found to be allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles L. Patterson, Jr., Ph.D. whose telephone number is (703) 308-1834. The examiner can normally be reached on any day of the week from 7:30 AM until 4:00 pm.If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Wax, can be reached on (703) 308-4216. The fax phone number for this Group is (703) 305-4242.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [robert.wax@uspto.gov].All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Patterson
September 18, 1997

CHARLES L. PATTERSON, JR.
PRIMARY EXAMINER
GROUP 1800